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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,954	08/26/2003	David K. Okuley	HON-14810	3723

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EXAMINER

COMPTON, ERIC B

ART UNIT PAPER NUMBER

3726

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/647,954

Applicant(s)

OKULEY, DAVID K.

Examiner

Eric B. Compton

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 30-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-29 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 13, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 6-11, 14, 15, 17 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-29, in the reply filed on June 19, 2006, is acknowledged.
2. Claims 30-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Objections***

3. Claims 17 and 29 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Independent claims 1 and 18 are drawn to a holding device and a supply system incorporating a holding device, while dependent claims 17 and 29 are drawn to further limiting the part. The structure of the device/system of claims 1 and 29 is not necessarily further limited by the structure of the part as recited. In addition, Applicant is not claiming the combination of the device/system and part. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*,

Art Unit: 3726

75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-5, 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 00/41475 to Fischer.

Note: U.S. Pat. 6,824,657 to Fischer is a English language equivalent and is relied on as a translation. See rejections below.

6. Claims 1, 3-5, 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. 6,824,657 to Fischer.

Regarding claim 1, Fischer discloses a holding device for holding a plurality of ferromagnetic parts, comprising:

a holder (11) defining a plurality of cavities (41) which the parts (12) may be disposed, said cavities being spaced apart and arranged in a row (see Fig 1, showing rows);

a bar (23) movably mounted to the holder and disposed parallel to the row of the cavities, said bar including a plurality of spaced-apart magnetic bodies (33, 34) arranged in a row, said row being movable in the direction of the row of the cavities between first and second position, wherein when the parts are disposed in the cavities the bar is in the first position, the magnetic bodies are aligned with the cavities and the magnetic attraction forces generated by the magnetic bodies hold the parts in the cavities, and wherein when the parts are disposed in the cavities and the bar is in the second position, the magnetic bodies are not aligned with the cavities and the magnetic attraction forces generated by the magnetic bodies do not hold the parts in the cavities.

Regarding claims 3, a rotatable bearing may be provided on an end portion of the bar. See Fig. 5.

Regarding claim 4-5, and 12, see Figure 3 (showing guide pockets (41), base (14) and cover (16)).

Regarding claim 17, "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

***Claim Rejections - 35 USC § 103***

Art Unit: 3726

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer.

Fischer discloses the invention above, but not necessarily the claimed particulars.

Regarding claim 2, Fischer does not disclose providing a spring to bias the bar in the first position. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the holder of Fischer with a biasing spring, in order to have a default position for the device. See e.g., U.S. Pat. 2,976,075 (showing a biasing spring for a magnetic pick-up device).

Regarding claims 4, 9-11, 13, and 16, Fischer does not disclose the specific type of magnetic and non-magnetic materials. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the holder of Fischer with the claimed materials, in order to efficiently hold the parts in the cavities of the device. The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

***Allowable Subject Matter***

9. Claims 18-29 are allowed.
10. Claims 6-11 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 18, the prior art of record does not teach or suggest a supply system comprising: a mounting structure; a holding device (as claimed); and at least one actuation structure positioned such that an end portion of the bar contacts the at least one actuation structure during the movement of the mounting structure between the return position and the load position, wherein such contact between the at least one actuation structure and the end position of the bar moved the bar to the second position, in combination with the other claimed subject matter.

Regarding claim 6, the prior art of record does not teach a holding device (as claimed in the parent claims), wherein the bores in the holding structure extend through a surface of the holding structure so as to form a plurality of slots in the holding structure that extend along the lengths of the bores, in combination with the other claimed subject matter.

Regarding claim 14, the prior art of record does not teach a holding device (as claimed in the parent claims), wherein the bar further comprises a contact device secured to an end portion of the base, said contact device comprising a head defining a

Art Unit: 3726

socket that rotatably holds a spherical bearing, in combination with the other claimed subject matter.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Eric B. Compton  
Primary Examiner  
Art Unit 3726

ebc